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09/597,893	06/19/2000	John S. Hendricks	SEDN/5199	5097

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EXAMINER	
LONSBERRY, HUNTER B	
ART UNIT	**PAPER NUMBER**
2623	

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/597,893	HENDRICKS ET AL.	
	Examiner	Art Unit	
	Hunter B. Lonsberry	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-26,28-45 and 51-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9-26, 28-45 and 51-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/628,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying breadth, For example note the following relationship between the instant application claim 1, and copending Application No. 09/628,805 claim 1 (which includes all of the claim language of copending claim 1):

a) "A method for targeting virtual advertisements at a users terminal" (line2) of the instant application corresponds to "a method for targeting virtual advertisements to terminals," (line 2) of copending Application No. 09/628,805.

b) the claimed "assigning at least one virtual advertisement spot to a video program" (line 3) of the instant application corresponds to "assigning at least one virtual advertisement spot to a video program" (line 3) of the copending Application No. 09/628,805.

c) the claimed "assigning one or more virtual objects to the at least one virtual advertisement spot" (lines 4-5) corresponds to "assigning one or more virtual objects to the at least one virtual advertisement spot" (lines 4-5) of the copending Application No. 09/628,805.

d) The claimed "generating a retrieval plan, wherein the retrieval plan directs the terminal to select one of the one or more virtual objects for placement at said at least one virtual advertisement spot in said video program" (lines 6-8) corresponds to "generating a retrieval plan; and providing the retrieval plan to the terminal, wherein the retrieval plan directs the terminal to select one of the one or more virtual objects for placement at said at least one virtual advertisement spot in said video program" (lines 6-9) of the copending Application No. 09/628,805.

It would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth.

Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending

Application No. 09/628,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to a method of targeting virtual objects, in which a program contains virtual object locations, virtual objects and alternate virtual objects are provided for a location and a retrieval plan it utilized to designate which location displays an alternate virtual object.

Claim 32 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 34 of copending Application No. 09/628,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to a method of assigning virtual objects to a location in a video program, by identifying the video program to carry a virtual object, assigning the object to a categories, ranking the video programs, ranking the objects and then determining which objects have the highest ranking for each category, assigning default and alternate objects to the object locations.

Claim 42 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 43 of copending Application No. 09/628,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to a method of targeting virtual objects by gathering information on a subscriber to generate a profile,

correlating a profile to a virtual object category and then selecting the virtual object to display for a subscriber.

Claim 51 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 51 of copending Application No. 09/628,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to a routine which targets virtual objects to an individual viewer, and utilizes a group definition routine to determine target categories, a group assignment routine that assigns a terminal to a group, a virtual object location routine which determines object locations in a video program, and a retrieval plan generator which retrieves an object for display based on group characteristics.

Claim 54 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 54 of copending Application No. 09/628,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to method of targeting virtual objects to terminals, identifying individual terminals by their characteristics, identifying virtual object locations within programs for display at the terminals, and integrating the virtual objects for inserting into a location based on the identities of the terminals

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

2. Applicant's arguments, see After Final Amendment, filed 3/23/06, with respect to claims 1-7, 9-26, 28-45 and 51-58 have been fully considered and are persuasive. The Final Rejection of 1/24/06 has been withdrawn.

The Examiner has withdrawn the 103 Rejections with respect to claims 1-7, 9-26, 28-31, 42-45 and 51-58, however a new rejection has been made to claims 32-41 in view of the Dedrick reference.

Applicant's failure to properly traverse the Official Notice(s) taken in the prior action is viewed as admission of prior art.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 51 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Data structures not claimed as being embodied in computer readable media are descriptive material per se, and are not

statutory as they are not capable of causing functional changes in the computer. In particular the preamble of claim 51 states, "A routine, executable on a general purpose computer, for targeting virtual objects to an individual viewer and to groups of viewers, the routine, comprising:" The Examiner suggests Applicant consult page 52 of the Interim 101 guidelines for appropriate language for a computer readable medium claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 32-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,177,931 B1 to Alexander (of record) in view of U.S. Patent 6,493,872 to Rangan (of record), U.S. Patent 5,991,735 to Gerace (of record) and U.S. Patent 5,724,521 to Dedrick.

Regarding claim 32, Alexander discloses a method for assigning targeted virtual objects in a program comprising,

Identifying a program to carry a targeted virtual object (column 33, lines 26-36),

Assigning the virtual objects to target categories (column 34, lines 16-18),

Dividing the categories into groups of viewers (column 34, lines 16-18)

Ranking one or more of the programs based on target categories and a first percentage of total viewers in one o more groups of viewers (column 34, lines 36-41),

Ranking the targeted virtual objects... (column 34, lines 36-43)

Determining for one of the programs... (column 34, lines 58-63)

Assigning one or more objects as default objects (column 34, lines 58-63)

Assigning alternate objects (column 34, lines 58-63)

Assigning the objects to the virtual objects locations (column 34, lines 58-column 35, line 2).

Alexander fails to disclose providing a retrieval plan and video program to the terminal, determining the placement of a virtual advertisement spot in a video program, and reporting the assigned virtual objects from the terminals to a remote location and ranking the video programs and targeted virtual objects based on a first and second percentage of total viewers.

Rangan discloses a method for adding text overlays, graphic icons and logos for advertisement over a video data stream (column 6, lines 38-50), advertisements may be associated with a tracked object or may be set to track along with an object or appear in a fixed position anywhere on a screen (column 6, lines 6-16, column 17, lines 15-33), a retrieval plan 55 (annotation stream) is transmitted along with a video stream 53 to a user device which instructs the device where to position the advertising data (column

13, line 18-column 14, line 20), thus enabling advertising content to be placed anywhere on a screen while a user watches a program.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Alexander to utilize the video programs and retrieval plans of Rangan, thus enabling advertising content to be placed anywhere on a screen while a user watches a program.

The combination of Alexander and Rangan fails to disclose reporting to the remote location the advertisements selected by the retrieval plan and ranking the video programs and targeted virtual objects based on a first and second percentage of total viewers.

Gerace discloses a user profiling system that sends targeted advertisements to a plurality of users, and tracks which advertisements are displayed to each users, as well as if the users request more information regarding the advertisement, this information is reported back to an advertisement provider in order to determine the effectiveness of the advertisements and allow the advertiser to fine tune their intended audience (column 5, lines 43-67, column 7, lines 16-47, column 13, lines 31-55, column 17, lines 27-44, column 18, lines 13-53).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Alexander and Rangan to utilize the reporting and refining features of Gerace, thus enabling an advertiser to ascertain the effectiveness of their advertisements and refine their target audience.

The combination of Alexander, Rangan and Gerace fails to disclose ranking the video programs and targeted virtual objects based on a first and second percentage of total viewers.

Dedrick discloses a method for providing electronic ads to a number of users via a consumer scale matching process, consumer profiles and preferences are collected (column 3, lines 35-59) , a advertiser utilizes a software tool to generate a consumer scale for each ad, a number of variables for each advertisement are multiplied by a number of weights for each advertisement, and a certain threshold weight must be met before an advertiser agrees to pay/match an advertisement (column 4, lines 3-15, line 59-column 6, line 33, 55-column 7, line 35, column 12, lines 9-16), thus ensuring that users receive advertising which is tailored to their interests, and that advertisers are provided with potential customers who are most interested in their products.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Alexander, Rangan and Gerace to utilize the selection, ranking and weighting features of Dedrick for the advantage of ensuring that users receive advertising which is tailored to their interests, and that advertisers are provided with potential customers who are most interested in their products.

Regarding claims 33-34, Alexander discloses the percentages are based on programs watched data and viewer demographics (column 28, lines 13-21, column 29, lines 43-44, column 30, lines 29-38).

Regarding claim 35, Alexander discloses:

Generating a group assignment matrix and providing it to one or more of the terminals (column 32, lines 45-48),

Generating and providing a retrieval plan to the terminal (column 32, lines 41-45)

Providing a program 10 to the terminals, the program including at least one virtual object location 14 (Figure 1).

Regarding claim 36, Alexander discloses that the retrieval plan and group assignments may be updated and sent back to the terminals (column 29, lines 14-30, column 33, lines 9-15, column 34, lines 49-55).

Regarding claim 37-38, Alexander discloses that the targeted objects, retrieval plan and group assignment matrix may be transmitted over the Internet (column 29, lines 31-37, column 33, lines 44-56).

Regarding claim 39, Alexander discloses that the objects may be transmitted from a cable network (headend, column 32, lines 45-51).

Regarding claim 40, Alexander discloses that the advertisements may be transmitted with the program (column 32, lines 55-56).

Regarding claim 41, Alexander discloses that the advertisements may be transmitted separately from the program (column 33, lines 44-47).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HBL

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